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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/755,451	01/13/2004	Wolfgang Flugge	104569-300	1089

28765 7590 04/05/2005

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WASHINGTON, DC 20005-3502

EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/755,451	Applicant(s) FLUGGE ET AL.	
	Examiner Daniel A. Hess	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-18 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This action is in response to the 1/13/2004 filing by the applicant.

Claim Objections

In independent claims 1 and 10, there appears to be at least one grammatical problem. The phrase “apply anti-tearing to a subset of data element...” should have the word “elements.” Appropriate correction for both claims 1 and 10 is required.

Claims 3-5 and 12-14 are objected to because of the following informalities: the term “the anti-tearing classifications” is used, when the term “said anti-tearing classifications” would be better to establish antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 13 and 14 recited the limitation “the anti-tearing classifications” in the first line of each. There is insufficient antecedent basis for this limitation in the claims. This problem

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can be corrected by changing the dependency of each of the above claims to depend from claim 11 rather than claim 10.

Claims 3-5 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

The above claims fail to clearly convey that data may be written to memory on the card in multiple ways that that the different classifications of parallel, circular and alternate represent different ways of writing data. Further, there is nothing in the claim to indicate what the term 'parallel', 'circular', or 'alternate' actually means, and thus the claims amount to nothing more than attaching a label to some indefinite classification, in other words naming the classification without defining it.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 6-9, 10, 11 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guthery (US PG Pub No. 2003/0115227) in view of Bouthillier et al. (US 6021497).

Re claims 1 and 10: It is understood that in every smart card, individual data elements must be located. Anti-tearing is (see entire Guthery document; anti-tearing is discussed throughout) applied to that subset of files which are being written at a particular time. Regarding the limitation, "provide related functionality for the current application," this limitation is very broad; it can be expected that data which provides related functionality will be written at the same time and thus subjected to an anti-tearing application at the same time. [Note: There is nothing in this limitation to convey clearly how datasets are broken down.]

Guthery fails to teach a network of card readers.

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Bouthillier et al. teaches throughout (see notably abstract) that card readers may be networked.

In view of Bouthillier et al.'s teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to operate the old and well-known anti-tearing capable card reader system within a network of readers, because a network of readers achieves more complex security functions. For example, at the USPTO buildings, there is a network of card reader systems which together operate to achieve a security envelope around the buildings.

Re claims 2 and 11: Guthery identifies (paragraph [0088]) different anti-tearing classifications for which different algorithms are applied, namely (a) data that is presently being written, and (b) data that was improperly written earlier.

Although this may not be the type of classification and type of different application of anti-tearing that the applicant had in mind, the claims do not clearly specify what is meant by different classifications. Even claims 3-5 and 12-14 do not clearly convey the full meaning of different classifications, as the 112 rejection above shows.

Re claims 6 and 15: At restart, Guthery must ([0088]) determine which data is invalid on startup of the smart card. In so doing, Guthery is implicitly identifying which data is valid (i.e. all data that is not invalid. The 'write-in progress bit' which is referred to throughout Guthery achieves this. See figure 7, especially. A file table including such bits would constitute the claimed list.

Re claims 7, 16: See figure 7: A 'read direction bit' also serves a partial role in determining which data is not fully valid and proper. A file table including such bits would constitute the claimed list.

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Re claims 8 and 17: If a file table is small, there is no reason why it could not be less than or equal to a memory block on the cards.

Re claims 9 and 18: Anti-tearing will be applied to any data that is written to the smart card of Guthery. If the reader has is prepared to write a particular piece of data, it is inherent that antitearing will be applied to that data.

Allowable Subject Matter

The concept of applying different anti-tearing based on different ways that data is written to the smart card as discussed in the specification was not found by the examiner. However, this concept is not believed to be conveyed in the claims. The claims would have to be rather more detailed, to distinguish technically between different ways of writing so that the different classification categories of claims 3-5 and 12-14 have real meaning.

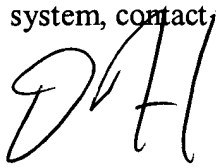
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH

DANIEL STCYR
PRIMARY EXAMINER

